

Attorney Docket No. 990092

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REMARKS

Claims 1-55 are pending in the present application, of which claims 1, 11, 21, 31, 41 and 52-55 are independent. Claims 1-2, 10-12, 20-22, 30-32, 40-41 and 43-51 have been amended to better claim the invention and to correct inadvertent errors. Claims 42, 52, 53, 54, and 55 have been canceled, without prejudice. Applicant respectfully submits that the remaining claims 1-41 and 43-51 are in condition for allowance.

Claim Rejections – 35 USC § 112

Claims 1, 11, 21, 31, 41, and 54 have been rejected under 35 USC section 112 paragraph two. Applicant has amended claims 1, 11, 21, 31 and 41 to address their rejection. Support for these amendments can be found, for example, on page 5, lines 12-14 and page 6, lines 10-20 of the patent application.

Claim Rejections – 35 USC § 103

Claims 1-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,169,799 by McIntosh (hereinafter "McIntosh"), in view of U.S. Patent No. 4,490,583 by Bednarz et al. (hereinafter "Bednarz"). The rejection is respectfully traversed.

"To establish a *prima facie* case of obviousness ...the prior art reference (or references when combined) must teach or suggest all the claim limitations."

MPEP 2143.

Regarding the amended independent claim 1, Applicant respectfully submits neither McIntosh nor Bednarz independently or combined teaches or suggests at least one limitation specified in claim 1. For example, the cited prior references fail to teach or suggest the limitation of "*sending at least the suffix portion of the number corresponding to the second state to the calling device*" (hereinafter the "sending element").

Turning first to McIntosh, it discloses amongst other things a telephone set or calling device having a processor that functions as an automatic area-code dialer. More specifically, if a user of the calling device confirms that a telephone number, which has been dialed by the calling device, is a frequently-dialed telephone number, "the processor stores the last seven digits of the

telephone number as the called party number portion 220. The digits preceding the called party number portion 220 are stored as the area code portion 210." *Column 3, line 45 – Column 4, line 11.* "[W]hen the caller re-dials the seven-digit number, the correct area code is automatically dialed also. Thus, the caller need not remember numerous ten-digit telephone numbers." *Column 2, lines 6-8.* Since the processor of the calling device already stored the frequently-dialed telephone number associated with the called device, there is no need for that same telephone number to be sent to the calling device. Accordingly, Applicant respectfully submits that McIntosh fails to teach or suggest the sending element.

With respect to Bednarz, the Examiner relies on Column 10, lines 1-40 of Bednarz for disclosing the sending element. *Office Action, page 3.* As apparent from its heading, the cited section of Bednarz discusses how Bednarz's plural line telephone controller could handle conference calls. More specifically, for conferencing of, e.g., outgoing calls, "it is desirable to place any previously established calls on hold when dialing an additional outgoing call so that the dial pulses from telephone 31 are not transmitted over the line already in use." *Column 10, lines 34-39.* Assuming *arguendo* the telephone 31 is similar to the calling device, the cited section is silent on how the number that is used for dialing the additional outgoing call is known by the telephone 31. In contrast, claim 1 specifies at least the suffix portion of the number corresponding to the second state is sent to the calling device. Accordingly, Applicant respectfully submits that Bednarz fails to teach or suggest the sending element.

Based on the above discussion, claim 1 should be non-obvious and patentably distinguishable over the cited prior art references, which fail to teach or suggest all the claim limitations.

Regarding claims 2-10, they depend from independent claim 1, which is believed to be patentable, and thus they should also be non-obvious and patentably distinguishable over the cited prior art references. *MPEP 2143.03.*

Regarding independent claim 11, it comprises at least one limitation that is similar to at least one limitation of claim 1, which is believed to be patentable. For example, claim 11 comprises a limitation regarding "*receiving at least the suffix portion of the number corresponding to the second state from the called device*" (hereinafter the "*receiving element*"). As discussed above, the cited prior art references fail to teach or suggest the sending element and thus it logically follows the cited prior art references also fail to teach or suggest the receiving

Attorney Docket No. 990092

element. More specifically, if at least the suffix portion of the number corresponding to the second state is **not sent** to the calling device, such calling device would **not receive** at least the suffix portion of the number corresponding to the second state especially from the called device. Accordingly, claim 11 should be non-obvious and patentably distinguishable over the cited prior art references.

Regarding claims 12-20, they depend from independent claim 11, which is believed to be patentable, and thus they should also be non-obvious and patentably distinguishable over the cited prior art references. *MPEP 2143.03.*

Regarding independent claim 21, it comprises at least one limitation that is similar to at least one limitation of claim 1, which is believed to be patentable. Accordingly, claim 21 should be non-obvious and patentably distinguishable over the cited prior art references for reasons similar to those discussed above regarding claim 1.

Regarding claims 22-30, they depend from independent claim 21, which is believed to be patentable, and thus they should also be non-obvious and patentably distinguishable over the cited prior art references. *MPEP 2143.03.*

Regarding independent claim 31, it comprises at least one limitation that is similar to at least one limitation of claim 1, which is believed to be patentable. Accordingly, claim 31 should be non-obvious and patentably distinguishable over the cited prior art references for reasons similar to those discussed above regarding claim 1.

Regarding claims 32-40, they depend from independent claim 31, which is believed to be patentable, and thus they should also be non-obvious and patentably distinguishable over the cited prior art references. *MPEP 2143.03.*

Regarding independent claim 41, it comprises at least one limitation that is similar to at least one limitation of claim 11, which is believed to be patentable. Accordingly, claim 41 should be non-obvious and patentably distinguishable over the cited prior art references for reasons similar to those discussed above regarding claim 1.

Regarding claim 42, it has been canceled, without prejudice, and thus its rejection is moot.

Regarding claims 43-51, they depend from independent claim 41, which is believed to be patentable, and thus they should also be non-obvious and patentably distinguishable over the cited prior art references. *MPEP 2143.03.*

Regarding claims 52-55, they have been canceled, without prejudice, and thus their rejection is moot.

Attorney Docket No. 990092

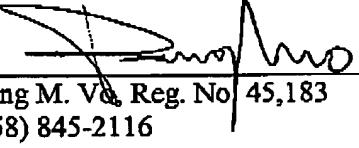
CONCLUSION

In light of the amendments and above remarks, Applicant respectfully submits that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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